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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/576,414

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EXAMINER

AUGHENBAUGH, WALTER

ART UNIT

PAPER NUMBER

1794

NOTIFICATION DATE

DELIVERY MODE

09/25/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentmail@whda.com

Office Action Summary	Application No. 10/576,414	Applicant(s) WATANABE ET AL.	
	Examiner WALTER B. AUGHENBAUGH	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/19/06 and 10/03/06</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The abstract of the disclosure is objected to because phrases such as "It is an object of the invention to obtain..." (line 1) should be avoided, the abstract appears to be too long (more than 15 lines, appears to be more than 150 words), and the indefinite language identified in the 35 U.S.C. 112, second paragraph, rejection made of record below (correct/clarify the indefinite language in the abstract so that the language of the abstract conforms to that which is definitely recited in the claims). Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-4 and 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In regard to claims 1-4 and 6-8, the metes and bounds of the scope of structures Applicant intends to delineate by the recitation “characterized in that interlayer resin (3) which makes up an intermediate resin layer of the multilayered molten resin mass is embedded eccentrically towards the bottom within inner/outer layer resin (2) making up the inner and outer layers” cannot be ascertained for the following reasons:

-it cannot be ascertained whether or not Applicant intends to limit the “inner/outer layer resin (2)” to (A) a single component (for example, as is shown in Fig. 1, in which “inner/outer layer resin (2)” encompasses “interlayer resin (3)”), or if Applicant intends “inner/outer layer resin (2)” to also include (B) two separate layers (“inner and outer layers”) between which the interlayer resin (3) is located. The recitations “inner/outer layer resin (2)” and “the inner and outer layers” are the reason for this uncertainty: the first recitation suggests that the scope of structures is limited to option (A) identified above, and the second recitation suggests that the scope of structures is open to option (B) identified above (“layer” compared with “inner and outer layers”). Clarification and/or correction is required.

The structure that Applicant intends to recite by “eccentrically” cannot be ascertained. There does not appear to be a definition for what Applicant intends to recite by “eccentrically” in the specification, and it is not believed that this is a typical word used to describe how one layer is embedded within a layer (or between two layers). Clarification and/or correction is required.

The structure that Applicant intends to recite by “eccentrically towards the bottom” cannot be ascertained. There does not appear to be a definition for what Applicant intends to recite by “eccentrically towards the bottom” in the specification (or for “towards the bottom” aside from the term “eccentrically”), and it is not believed that this is a typical phrase used to

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describe how one layer is embedded within a layer (or between two layers). Clarification and/or correction is required.

The structure that Applicant intends to recite by "embedded eccentrically towards the bottom within inner/outer layer resin (2) making up the inner and outer layers" cannot be ascertained. It cannot be ascertained whether or not Applicant intends to require that the "inner/outer layer resin (2) making up the inner and outer layers" must completely surround the layers or not. For example, does Applicant intend to allow for the bottom, or a part of the bottom, of the interlayer resin (3) to be exposed (while the remainder is covered by the "inner/outer layer resin (2) making up the inner and outer layers")? Clarification and/or correction is required.

In further regard to claims 4, 7 and 8, it cannot be ascertained whether or not Applicant intends to recite two separate articles, one of the two articles recited in these claims, or one article that is both a product and a preform. Are two separate articles recited in claims 4, 7 and 8? (both the product and the preform?) Or is only one article required by claims 4, 7 and 8? (a choice between the product and the preform?) Are the product and the preform intended to be the same thing (if so, the scope of the claim would be clear if "product" were deleted from claims 4, 7 and 8, and claims 4, 7 and 8 were otherwise appropriately amended (that is, does Applicant intend "molded" to apply to the preform?) Clarification and/or correction is required.

Claims 2-4 and 6-8 are also rejected because they depend upon claim 1, which is indefinite for the reasons discussed above.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3, 4, 5 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Shimizu et al. (USPN 4,816,308).

In regard to claim 1, Shimizu et al. teaches a resin mass having structural characteristics that correspond to the structural limitations that are positively recited in claim 1. See, for example, Fig. 3, and alternatively, Fig. 4.

In regard to claim 3, Shimizu et al. teaches an interlayer having structure that corresponds to the claimed structure. Compare Fig. 3 of Shimizu et al. with Applicant's Fig. 1.

In regard to claim 4, Shimizu et al. teaches a product and preform having structural characteristics that correspond to the structural limitations that are positively recited in claim 4. See, for example, Fig. 3, and alternatively, Fig. 4.

In regard to claim 5, Shimizu et al. teaches a container having structural characteristics that correspond to the structural limitations that are positively recited in claim 5. See, for example, col. 5, lines 45-55.

In regard to claim 8, Shimizu et al. teaches a product and preform having structural characteristics that correspond to the structural limitations that are positively recited in claim 4. See, for example, Fig. 3, and alternatively, Fig. 4.

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7. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Collette et al. (USPN 5,759,653).

In regard to claim 1, Collette et al. teaches a resin mass having structural characteristics that correspond to the structural limitations that are positively recited in claim 1. See, for example, Fig. 4, and alternatively, Fig. 5.

In regard to claim 2, the recited distance of Collette et al. is 0 at the lowest point of the preform. See, for example, Fig. 4, and alternatively, Fig. 5.

In regard to claims 3 and 6, Collette et al. teaches an interlayer having structure that corresponds to the claimed structure. Compare Fig. 4 and 5 of Collette et al. with Applicant's Fig. 1.

In regard to claims 4, 7 and 8, Collette et al. teaches a product and preform having structural characteristics that correspond to the structural limitations that are positively recited in claim 4. See, for example, Fig. 4, and alternatively, Fig. 5.

In regard to claim 5, Collette et al. teaches a container having structural characteristics that correspond to the structural limitations that are positively recited in claim 5. See, for example, Fig. 6.

8. Claims 1, 3, 4 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Kuwabara et al. (JP 03-234604) (English abstract filed with IDS).

In regard to claim 1, Kuwabara et al. teaches a resin mass having structural characteristics that correspond to the structural limitations that are positively recited in claim 1. See English abstract text and figures.

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In regard to claim 3, Kuwabara et al. teaches an interlayer having structure that corresponds to the claimed structure. Compare figures of English abstract with with Applicant's Fig. 1 (note the top of interlayer of Kuwabara et al. on either side is curved).

In regard to claims 4 and 8, Kuwabara et al. teaches a product and preform having structural characteristics that correspond to the structural limitations that are positively recited in claim 4. See English abstract text and figures.

9. Claims 1, 3, 4, 5 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Kuwabara et al. (JP 03-234604).

In regard to claim 1, Kuwabara et al. teaches a resin mass having structural characteristics that correspond to the structural limitations that are positively recited in claim 1. See figures 3A-3D.

In regard to claim 3, Kuwabara et al. teaches an interlayer having structure that corresponds to the claimed structure. Compare figures 3A-3D with Applicant's Fig. 1 (note the top of interlayer of Kuwabara et al. on either side is curved).

In regard to claims 4 and 8, Kuwabara et al. teaches a product and preform having structural characteristics that correspond to the structural limitations that are positively recited in claim 4. See figures 3A-3E and 4.

In regard to claim 5, Kuwabara et al. teaches a container having structural characteristics that correspond to the structural limitations that are positively recited in claim 5. See, for example, Fig. 5.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 2, 3 and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimizu et al. (USPN 4,816,308).

In regard to claim 2, Shimizu et al. teach the resin mass as discussed above in regard to claim 1. While Fig. 3 in particular appears to show a distance that corresponds to the claimed distance that is close to, if not about, 10%, Shimizu et al. teach that the relative amount of the resins A and B may vary widely and that it is desirable to achieve good transparency (col. 4, lines 37-57), it would have been obvious to one of ordinary skill in the art at the time the invention was made to have varied the thickness of the bottom layer of resin A, such as to decrease its thickness in order to achieve the desired degree of transparency, depending on the particular desired end results, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art in the absence of unexpected results. *In re*

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Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). MPEP 2144.05 II.B. Since Resin B is the barrier layer, minimizing the thickness of the layers of resin A will not substantially affect the barrier properties of the container from which the resin mass is formed if at all.

In regard to claims 3 (if Applicant convincingly argues/shows that the interlayer of Shimizu et al. has structure that corresponds to the claimed structure) and 6, the recitations of these claims related to the particular shape of the interlayer resin. Shimizu et al. teaches an interlayer having structure that corresponds to the structure claimed in claims 3 and 6. Furthermore, Shimizu et al. teach that the relative amount of the resins A and B may vary widely and that it is desirable to achieve good transparency and gas barrier properties (col. 4, lines 37-57), it would have been obvious to one of ordinary skill in the art at the time the invention was made to have varied the shape of the interlayer resin in order to achieve the desired degree of gas barrier properties, or the desired balance of transparency and gas barrier properties (for example, to achieve a particular thickness of gas barrier layer in the container formed from the resin mass), depending on the particular desired end results, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art in the absence of unexpected results. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). MPEP 2144.05 II.B.

In regard to claims 7 and 8, Shimizu et al. teaches a container having structural characteristics that correspond to the structural limitations that are positively recited in claim 5. See, for example, col. 5, lines 45-55.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is (571) 272-1488. The examiner can normally be reached on Monday-Thursday from 9:00am to 7:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Walter B Aughenbaugh /
Examiner, Art Unit 1794

9/22/09